

BEST AVAILABLE COPYAttorney's Docket: 2000DE135
Serial No.: 10/004,601
Art Unit: 1756REMARKS

The Office Action mailed October 18, 2004, has been carefully considered. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the Application as originally filed. No new matter has been introduced. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

Claim Status

Claims 1-16 and 18-20 are pending in this Application. By this Amendment, claims 1 and 4 have been amended while new claim 22 has been added. Given the amendment to claim 1, claim 3 has been cancelled. Thus, the claims under consideration are believed to include 1, 2, 4-16, 18-20 and 22.

Election/Restrictions

The Office has required Applicants to limit the claims to the elected invention in order to advance prosecution should the elected invention be found allowable.

As stated by the Office, Applicants elected electrophotographic toners and developers as the elected species and further, that the toner is defined as a dry toner and the pigment is an azo pigment. On or about October 27, 2004, the undersigned had a telephone discussion with Examiner Rodee wherein the election/ restriction was discussed. In that conversation, the undersigned put forward the position that as claim 1 was anticipated to be allowable, Applicants should be entitled to an additional number of species for both the azo pigment and the electrophotographic toner. In that discussion, the Examiner advised the undersigned that the Office would be willing to except electrophotographic toners and developers and azo pigments and polycyclic pigments. In consequence, independent claim 1 has been amended to read that the wax coated pigment particles comprise an organic pigment and that the organic pigment is an azo pigment or a polycyclic pigment. Furthermore, the claim has been amended to

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delete all compositions other than electrophotographic toners and electrophotographic developers.

During the aforementioned conversation, the undersigned also presented the position that as a dry toner was elected as a species, under MPEP § 809.02(c) Applicant believes that they are entitled to additional species within the genus of electrophotographic toners. In consequence, Applicants have added new claim 22, reciting that the electrophotographic toners are selected from the group consisting of liquid toners in high boiling solvents and electrocoagulation toners on an aqueous basis. Basis for this claim is found, *inter alia*, on page 23, paragraphs 0076 and 0077. New claim 23 now recites the toner as a dry toner.

Claim Rejections Under 35 USC § 103

Claims 1-10, 12-16 and 18-21 stand rejected under 35 USC § 103(a) as being unpatentable over Handbook of Imaging Materials to Diamond, pp. 162-171 & 193-197 in view of Metz et al. in US Patent 6,485,558, and further in view of JP 3-168760.

Claims 10 and 11 stand rejected under 35 USC § 103(a) as being unpatentable over Handbook of Imaging Materials to Diamond, pp. 162-171 & 193-197 in view of Metz et al. in US Patent 6,485,558, further in view of JP 3-168760, as applied to claims 1-10, 12-16, and 18-21 above, and further in view of Macholdt et al. in US Patent 6,159,649. These rejections are respectfully traversed.

In the previous Amendment, faxed August 6, 2004, Applicants attempted to traverse these rejections based upon the provisions of § 103(c). Specifically, Applicants enclosed a declaration of common ownership under 35 USC § 103(c). In this Office Action, the Office finds that the declaration of common ownership is insufficient to remove the rejection because "it is not clear that the 'claimed invention' was subject to an assignment or commonly owned." The Office states that "although the inventors were subject to an assignment obligation to Clariant GmbH, the declaration does not make clear that it is the claimed invention that was subjected to the obligation."

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Attached herewith is a substitute declaration of common ownership which specifically states that the inventors, as they were employed by Clariant GmbH, were obligated to assign the claimed Invention to Clariant GmbH.

The Office also finds that the previously asserted declaration "unclear if the individuals who signed the declaration have the authority to act in this application on behalf of the inventions owner.

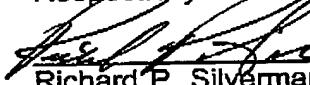
The title "authorized signatory" combined with "ppa" or "i.V." in front of a signature provide the signatory, under German Law, to sign on behalf of the assignee, Clariant GmbH. With respect to their capacity within the organization, both signatories are European Patent Attorneys employed by Clariant GmbH.

In view of the substituted declaration, and the remarks provided above, it is respectfully contended that the declaration of common ownership is in acceptable form, and therefore, applicants respectfully solicit reconsideration and withdrawal of the § 103 rejections for the reasons advanced in Applicants' previous Amendment mailed August 6, 2004.

As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However if an additional fee is required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

In view of the forgoing amendments and remarks, the present Application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,


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